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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,277	06/10/2006	Allan Nielsen	10527.204-US	1622
25908 7590 11/03/2009 NOVOZYMES NORTH AMERICA, INC. 500 FIFTH AVENUE SUITE 1600 NEW YORK, NY 10110				
EXAMINER NOAKES, SUZANNE MARIE				
ART UNIT		PAPER NUMBER		
1656				
NOTIFICATION DATE		DELIVERY MODE		
11/03/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents-US-NY@novozymes.com

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/582,277

Applicant(s)

NIELSEN ET AL.

Examiner

SUZANNE M. NOAKES

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 19 October 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): the rejection made under 35 USC 112 1st paragraph - Enablement.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 41 and 46-65.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/SUZANNE M. NOAKES/
Primary Examiner, Art Unit 1656

Continuation of 11. does NOT place the application in condition for allowance because: The Examiner acknowledges the amendments filed 19 October 2009 which materially reduces the number of rejections and objections and thus said amendments are entered. Said amendments overcome the previous Enablement rejection and all other objections of record. Thus, the only remaining rejection of record is the rejection of claims 41 and 46-65 under 35 USC 102(b), Chen et al. (as cited on the IDS). It is Applicants position that the Examiner has interpreted the reference inaccurately in the following way: Applicants cited the passage on p. 297 from Chen et al, which states the introduction of the mrgA-lacZ fusion protein abolishes MrgA protein production in the progeny cells HB1032 as is evidenced by the SDS-PAGE gel in Figure 4. It is further stated that the HB1032 progeny strain does not contain a single copy of the MrgA gene and "is incapable of producing MrgA protein." (see Remarks filed 10/19/09, p. 6-7). And finally Chen et al. does not teach that progen cells produce more amounts of MrgA than the parent strain.

The Examiner, however, disagrees with these assertions and maintains her interpretation of Chen et al. is accurate. The passage that Applicants cite and their interpretation is noted, however, the Examiner interprets that this merely means that the insertion of the MrgA-LacZ fusion protein, which Applicants specifically also note and state, has been inserted into the chromosomal mrgA gene and thus disrupts the mrgA gene which exists in the parent strain. As such this abolishes the progeny strains (HB1032) ability to produce the chromosomal version of the MrgA protein; thus the lack of the 16 kDa and 113 kDa bands as shown in Figure 4. However, the fusion construct MrgA-LacZ inserted into the progeny cells/strain certainly exists and still produces a fully functional MrgA-LacZ fusion protein as required by the claim. Furthermore, when one looks at strain HB1022, and Figure 3, induction of the fusion protein MrgA-LacZ similarly in this strain produces 6-10 times more protein than without induction and thus more protein of interest (LacZ) and MrgA protein is produced as compared to the parent strain (see full last paragraph, p. 296 and Figure 3, p. 297). Recovery of the protein or interest would have been included in the B-gal assays wherein said assay was performed by lysing the cells, using the supernatant and testing for the beta-galactosidase activity.